

REMARKS/ARGUMENTS

The Examiner is thanked for the Notice of Non-Compliant Amendment dated November 25, 2005. This substitute amendment and request for reconsideration is intended to be fully responsive thereto.

The Examiner is thanked for the Official Action dated August 11, 2005. This amendment and request for reconsideration is intended to be fully responsive thereto.

Claims 2, 4, 5, 6 and 15 have been amended to correct minor inconsistencies.

Claims 1, 2, 5, 6, 8-10 and 12-18 were rejected under 35 U.S.C. 102(b) as being anticipated by Kometani et al. (USPN 5,720,790). The applicant respectfully disagrees.

The Examiner has erroneously asserted that Kometani discloses a seal (220) of substantially solid resilient thermoplastic material. This assertion is without merit, as the seal portion 220 (as well as the seal member 30) is made of non-woven fabric and is unitary with the pleated filter.

The filter element F has a filter portion 100 of a wavy sheet and a flange portion 200 framing the filter portion 100. These filter portion 100 and flange portion 200 are made of the same nonwoven fabric of chemical fiber (emphasis added). Column 3, lines 53-56.

On the other hand, the seal portion 220 is formed into a soft and thick or uncompressed felt-like sheet of a low density as compared with the connecting portion 210 and the protecting portion 230 (emphasis added). Column, 4 lines 25-28.

The seal member 30 is made of the same nonwoven fabric as the main fiber of the filter portion 10 and flange 20 (emphasis added). Column, 7 lines 28-29.

Thus, Kometani fails to disclose a filter element, having a filter media having filter face portions and at least one side portion joined thereto by a corner portion; and a seal of substantially solid thermoplastic material let alone such a seal disposed at the corner portion and having a bendable contact portion extending from an adjacent face portion. In fact the seal and flange of Kometani is unitary with the filter media and this can not be formed or disposed thereon.

For these reasons, Applicant respectfully submits that the applied document, *i.e.*, the '790 patent to Kometani, does not meet this standard of anticipation, and any rejection of claims 1-18 under 35 U.S.C. 102 or 103 is improper.

Claims 2, 4, 7, 11 and 19-25 were rejected under 35 U.S.C. 103 as being unpatentable over Kometani in view of Peng (USPN 6,864,195). Applicant respectfully disagrees.

Regarding claims 2, 4, 7 and 11: Firstly, Kometani fails to disclose the recited seal or such a seal formed of thermoplastic mater, let along the remaining limitations of claims 1 and 6. Thus this rejection the rejection is unsound for this reason alone. Moreover, Peng is directed to a roofing member, completely non analogous art. The Examiner has failed to provide the necessary motivation to combine the teachings of Peng with that of Kometani.

"In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant endeavor or, if not, then reasonably pertain to the particularly problem with which the invention was concerned. MPEP 2141.01(a).

Clearly the Examiner has attempted to reconstruct Applicants invention with the benefit of hindsight as the art of roofing material in no way relates or pertains to filter elements and filter media. Thus any rejection of claims 2-4, 6, 10 and 13-16 under 35 U.S.C. 103 are improper.

Regarding claims 19-25: Firstly, Kometani fails to disclose the recited method of making filter elements, comprising the step of injecting a seal around a face of the filter media, as the seal of Kometani is made of non-woven fabric and is unitary with the pleated filter, and the remaining steps of claims 19 and 23. Thus this rejection the rejection is unsound for this reason alone. Moreover, Peng is directed to a roofing member, completely non analogous art. The Examiner also has failed to provide the necessary motivation to combine the teachings of Peng with that of Kometani. Clearly the Examiner has attempted to reconstruct Applicants invention with the benefit of hindsight as the art of roofing material in no way relates or pertains to filter elements and filter media. Thus any rejection of claims 19-24 under 35 U.S.C. 103 is improper.

Appl. No. 10/762,240

In re Kirsch, M.

Reply to Notice of Non-Compliant Amendment of Nov. 25, 2005

The Examiner further noted that claims 1, 3, 5, 6, 8-10 and 12-18 of the present application conflict with claims 1, 4, 5, 7-9 and 11-16 of co-pending Application No. 10 /404,109. Applicant respectfully disagrees.

Regarding claim 1: claim 1 of the present invention recites the seal of substantially solid thermoplastic material, while claim 1 of the co-pending Application No. 10 /404,109 recites the seal of substantially solid resilient thermoplastic material and having a bendable contact portion homogenously formed unitarily with the solid resilient material.

Regarding claim 6: claim 6 of the present invention recites the seal of substantially solid thermoplastic material, while claim 5 of the co-pending Application No. 10 /404,109 recites the seal of substantially solid, cell-less resilient thermoplastic material.

A reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). Is there an embodiment of the invention that falls within the scope of one claim, but not the other? (MPEP 804.II.A).

Clearly, clearly, a claim reciting a “solid thermoplastic material” is not identical to or substantively the same as a claim reciting the cell-less resilient thermoplastic material because “solid thermoplastic material” is broader than “cell-less resilient thermoplastic material.”

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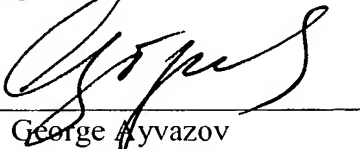
Therefore, the Double Patenting rejection of claims 1, 3, 5, 6, 8-10 and 12-18 of the present application is improper.

It is respectfully submitted that claims 1-25 define the invention over the prior art of record and are in condition for allowance, and notice to that effect is earnestly solicited.

Should the Examiner believe further discussion regarding the above claim language would expedite prosecution they are invited to contact the undersigned at the number listed below.

Respectfully submitted:

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